

REMARKS

Summary

Claims 1, 2, 4-9 and 11-14 were pending. Claims 1, 2, 4-9, and 11-13 were rejected; Claim 14 has been allowed. New Claims 15-17 have been introduced. No new matter has been added. The Applicant respectfully traverses the rejections.

Claim Rejections

35 U.S.C. § 112, first paragraph

Claims 1, 2, 4-9 and 11-13 were rejected on the basis of 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Applicant respectfully traverses this rejection. The Applicant respectfully submits that the application as filed (including the original claims) gives full support for the subject matter claimed in Claim 1. Further, this assertion is supported by the Examiner's response in dismissing a previous traverse.

The purpose of the written description requirement is to ensure that the applicants convey with reasonable clarity to those skilled in the art that they were in possession of the invention as of the filing date of the application. For the purposes of the written description requirement, the invention is "whatever is now claimed." *Vas-cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

At paragraph [003] (page 4; the paragraph numbering seems to have been restarted at page 4), for example, the specification recites that "regardless of the x-ray source angle of rotation with respect to rotation about the horizontal axis, the lower edge of the x-ray source is always located below the lower edge of the support arm...." Further, original Claim 1 expressed this as "independently of an x-ray source angle of rotation about the horizontal axis." Each of the separately, and certainly together, indicate that the condition is true for any rotation angle about the horizontal axis.

The Examiner refers to Figs 1, 2 and paragraph 8 of the specification as showing specific examples of 0 and 90 degrees rotation to support the rejection. However, this is only an example of a position of the X-ray apparatus, and to use an example to limit the claimed invention would be to read the limitations of the specific example, as illustrated in what must necessarily be a limited number of drawings, into the claims.

Elsewhere in the specification the independence with respect to the rotation angle is clearly set forth.

In responding to Applicant arguments in a previous Office action (November 9, 2007, page 7), the Examiner noted that the “features upon which the Applicant relies (i.e., a rotation of plus or minus 180 degrees measured from a reference position and the total angle of rotation of envelope limitation being 360 degrees) are not recited in the rejected claim(s).” “Although the claims may be interpreted in light of the specification, limitations from the specification are not read into the claims.” That is, the reason that the claim was rejected, was that limitations understood by the Examiner to present in, or equivalent to, the subject matter disclosed in the specification were not recited in the amended Claim 1. The Applicant has now amended the claims to recite the limitations, and it would be inconsistent with the prosecution history to now reject such claim limitations. Moreover, *ipsis verbis* disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question. *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978).

The Applicant emphasizes this aspect of the claimed invention by introducing new dependent Claims 15-17, further claiming sub-ranges of the disclosed invention (that is, for example, an angle greater than 180 degrees and less than 360 degrees). The Applicant is entitled to claim a range of a quantity that is smaller than the inclusive range disclosed. *In re Blaser*, 556 F.2d 534, 194 USPQ 122 (C.C.P.A., 1977).

35 U.S.C. § 102(b)

Claims 1, 2, 4, 5, 7 and 11-13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Khutoryansky et al. (US 5,636,259; “Khutoryansky”) in view of Mekker et al. (US 4,727,564; “Mekker”). The Applicants respectfully traverse the rejections on the basis that a *prima facie* case of obviousness has not been made out.

With respect to independent Claims 1 and 11, the Examiner accepts that Khutoryansky does not disclose rotation over an angle greater than 180 degrees, and depends on Mekker to remedy this deficiency. Khutoryansky is posited as the “base system” and the disclosure of Mekker is used to supply the missing element. This is

asserted to be an "improvement" on the "base system". The motivation for this improvement is said to be found in the abstract of Mekker as being "greater movement and flexibility". The abstract states that "[t]he masts move independently of one another but can also be linked together for movement in unison". There is no implication that this "greater movement and flexibility" applies to the rotation of the x-ray assembly 26, and any such motivation must be seen to arise from the Applicant's own claims.

The Office action cites fig. 4, reference numeral 50, as demonstrating that Mekker teaches a 360 degree rotation range. The apparatus 47 for mounting the x-ray assembly 26 to the mast 24 is manually operated, as may be seen from the dogs 104 used to secure the joint in the desired position. Khutoryansky teaches that the x-ray apparatus (Khutoryansky, fig 3, reference numeral 112, col. 12, line 60-bridging col.13, line 47) is rotated about the horizontal axis by a motor driven device, as part of the overall positioning and control function of the system. Substituting a manually rotatable joint into an automatically controlled system would not be seen as an improvement on the system described by Khutoryansky. More particularly, as the "base system" is intended to operate under automatic or computer control for positioning, the resultant combined system would be inoperative for its intended purpose. Such an inoperative combination cannot be used to make out a *prima facie* case of obviousness. In re Spinnoble, 405 F.2d 578, 587 (CCPA 1969).

Claims 2, 4, 5, 7, 12 and 13 are claims dependent on an allowable claim and are allowable, without more.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Khutoryansky and Mekker as applied to Claim 1, and further in view of Horbaschek (US 2002/0118793; "Horbaschek"). Claim 6 is dependent on allowable Claim 1, and is allowable, without more.

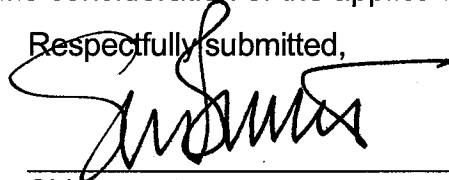
Conclusion

Claims 1, 2, 4-9 and 11-17 are pending.

For at least the reasons given above, the Applicant respectfully submits that the pending claims are allowable and looks forward to the early issuance of a Notice of Allowance.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Sid Bennett', written over a horizontal line.

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